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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,778	01/23/2002	Donna D. Holland	71710/56835	8739

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GENZYME CORPORATION
LEGAL DEPARTMENT
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EXAMINER

O CONNOR, CARY E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/18/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,778

Applicant(s)

HOLLAND ET AL

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-13, 17-25, 29, 31-35 and 39-48 is/are rejected.
- 7) ☒ Claim(s) 5-8, 14-16, 26-28, 30 and 36-38 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 9-13, 17-25, 29, 31-35, 39-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Evans et al (6,322,499).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Evans shows an illuminated retractor comprising a handle member 20 having a first handle member end portion 22 and a second handle member end portion 24, and a first elongate section 30 having proximal and distal end portions 34, 32 and a first inner surface 38 extending from the proximal end portion to near the distal end portion and

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having a substantially non-linear shape (because of the bent areas at the end portions) wherein the second handle member end portion is connected to the first elongate section by a twist connector and forms an acute angle therebetween (col. 7, lines 57-61). The second handle member end portion is pivotally connected to the first elongate member (col. 8, lines 59-60). The retractor also includes a second elongate section 40 having proximal and distal end portions and a second inner surface 48 extending between the ends. The second elongate section is connected to the first elongate section such that the sections are substantially aligned. The distal end portion of the second elongate section defines an illuminating output member 49. The proximal end portion of the first elongate section has an insertion area 39 for receipt of a portion of the second elongate section. As to claims 2, 3 and 11, the inner surface of the first elongate member is bent in the longitudinal direction and the second elongate outer surface has a bent shape that substantially corresponds to the shape of the first elongate inner surface. As to claims 4 and 13, note column 7, line 60. As to claims 9 and 20, note the chamfered surface 52 that has an angle in the range of 30 to 60 degrees. As to claims 17, 18 and 21, note column 10, lines 31-36. As to claims 19 and 22, the insertion area 47 is formed as a U-shaped flap. As to claim 43, note that the illumination input end 49 is coupled to the optical cable 27 through the twist connector.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard (6,554,768) in view of Hipps (6,228,025). Leonard shows an illuminated retractor comprising a handle member 20 having a first handle member end portion 22 and a second handle member end portion 24, and a first elongate section 30 having proximal and distal end portions 35, 37 and a first inner surface 38 extending from the proximal end portion to near the distal end portion and having a substantially non-linear shape (because of the bent areas at the end portions) wherein the second handle member end portion is connected to the first elongate section. The retractor also includes a second elongate section 40 having proximal and distal end portions and a second inner surface 48 extending between the ends. The second elongate section is connected to the first elongate section such that the sections are substantially aligned. The distal end portion of the second elongate section defines an illuminating output member 49. The proximal end portion of the first elongate section has an insertion area 39 for receipt of a portion of the second elongate section. Leonard does not show that the handle member forms an acute angle with the first elongate section. Hipps shows a retractor of the same type as Leonard wherein the handle forms an acute angle with the elongate members. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the handle and

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elongate members of Leonard at an acute angle to one another, in view of Hipps, so that adequate pulling forces may be applied to the retractor. As to claim 22, each of the insertion areas 39 are formed as a U-shaped flap. As to claim 23, the inner surface of the first elongate member is curved, in the transverse direction and bent in the longitudinal direction.

Allowable Subject Matter

Claims 5-8, 14-16, 26-28, 30, 36-38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Drawings


The corrected or substitute drawings were received on January 13, 2003. These drawings are approved.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-0858. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
June 16, 2003